

REMARKS

Claims 1-90 are now pending in the application. Applicant would like to thank the Examiner for the courtesy extended during the personal interview conducted on February 22, 2006. During the interview, Applicant's representative and the Examiner discussed the operation of Applicant's invention and the Examiner clarified his interpretation of the prior art. No agreement was reached. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-8, 12-20, 24-31, 35-42, 46-53, 57-64, 68-75, 79-86, and 90 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sunter et al, U.S. Pat. No. 6,204,694. This rejection is respectfully traversed.

Sunter fails to show, teach, or suggest changing a duration of m selected pulses to a second duration in response to a control signal.

For anticipation to be present under 35 U.S.C §102(b), there must be no difference between the claimed invention and the reference disclosure as viewed by one skilled in the field of the invention. Scripps Clinic & Res. Found. V. Genentech, Inc., 18 USPQ.2d 1001 (Fed. Cir. 1991). All of the limitations of the claim must be inherent or expressly disclosed and must be arranged as in the claim. Constant v. Advanced Micro-Devices, Inc., 7 USPQ.2d 1057 (Fed. Cir. 1988). Sunter fails to disclose the limitation of changing a duration of m selected pulses to a second duration in response to a control signal.

The Examiner relies on Column 5, Lines 1-13 of Sunter to disclose this limitation.

Applicant respectfully notes that the cited portion of Sunter states:

...a comparator for comparing the programmable frequency of the internal clock signal of a secondary oscillator unit with a reference frequency to produce a comparison result; a frequency controller for adjusting the programmable frequency of the internal clock signal of the secondary oscillator unit and controlling the first and second oscillator selectors to select a different ring oscillator from the secondary oscillator unit, based on the comparison result; and a unit controller for controlling the unit selector to switch the selection between the main oscillator unit and the secondary oscillator unit when frequency adjustment of the secondary oscillator unit is completed.

In other words, the Examiner alleges that changing the frequency of the internal clock signal is analogous to changing selected pulses of the clock signal. Applicant respectfully notes that Sunter discloses changing the frequency of the clock signal rather than changing selected pulses of the clock signal.

In contrast, Applicant's invention is directed to changing a duration of m selected pulses of a signal. For example, FIG. 1 illustrates a selected pulse 108B of a test clock signal 104 that is modified according to an exemplary embodiment of the invention. Modification of the selected pulse 108B does not affect durations of an immediately preceding pulse 108A and an immediately following pulse 108C.

As such, Applicant respectfully submits that Sunter fails to show, teach, or suggest the limitations of claim 1. Claim 1, as well as its dependent claims, should be allowable for at least the above reasons. Claims 1, 13, 25, 36, 47, 58, 69, and 80, as well as their corresponding dependent claims, should be allowable for at least similar reasons.

REJECTION UNDER 35 U.S.C. § 103

Claims 1, 13, 25, 36, 47, 58, 69, and 80 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Liguori, U.S. Pat. No. 6,059,836 and further in view of Sunter. This rejection is respectfully traversed.

Liguori, singly or in combination with Sunter, fails to disclose changing a duration of m selected pulses to a second duration in response to a control signal. The Examiner acknowledges that Liguori does not disclose changing the duration of each of m of the pulses to a second duration. The Examiner relies on Sunter to disclose this limitation. As described above with respect to the rejection under 35 U.S.C. § 102(b), Sunter fails to show, teach, or suggest changing a duration of m selected pulses.

Furthermore, Applicant respectfully asserts that there is no motivation to combine Liguori with Sunter et al. According to established mandates of the patent laws, “[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” **M.P.E.P. § 2142.**

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” **M.P.E.P. § 2143.01.** “The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” **In re Kotzab**, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). The

showing must be “clear and particular, and it must be supported by actual evidence.”

Teleflex, Inc. v. Ficosa North American Corp., 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374, 1387 (Fed. Cir. 2002) (quoting **In re Dembiczak**, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)) (emphasis added).

It is not sufficient to rely on “common sense and common knowledge,” as there must be specific evidence to support the motivation. **In re Lee**, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002). It is respectfully submitted that the Patent Office has made no showing of a motivation to combine based on actual, specific, evidence.

Rather, according to **M.P.E.P. § 2142**, “[t]o reach a proper determination under 35 U.S.C. 103, . . . impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of the facts gleaned from the prior art.” Furthermore, according to M.P.E.P. § 2143.01, “[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of [such modification].” **In re Mills**, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) Since the Patent Office has offered no proper support or motivation for combining the references, it is respectfully submitted that the rejection based on obviousness is clearly and unequivocally founded upon “knowledge gleaned only from applicant's disclosure.” **M.P.E.P. § 2145**. Consequently, it is respectfully submitted that the rejection entails hindsight and is, therefore, improper.

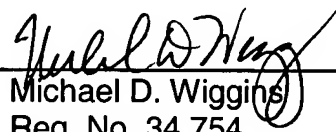
Applicant respectfully submits that claims 1, 13, 25, 36, 47, 58, 69, and 80 are allowable for at least these reasons.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: March 9, 2006

By: 
Michael D. Wiggins
Reg. No. 34,754

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

MDW/mp/dma